



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,540	10/11/2005	Shigeru Tanaka	81844.0044	2300

26021 7590 05/03/2007  
HOGAN & HARTSON L.L.P.  
1999 AVENUE OF THE STARS  
SUITE 1400  
LOS ANGELES, CA 90067

EXAMINER
----------

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
----------	--------------

1714

MAIL DATE	DELIVERY MODE
-----------	---------------

05/03/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/552,540

**Applicant(s)**

TANAKA ET AL.

**Examiner**

Patrick D. Niland

**Art Unit**

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10-20 is/are allowed.
- 6) ☒ Claim(s) 1-7, 9 and 21-23 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

Art Unit: 1714

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 9, and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 06-264035 Shinji et al. (Abstract provided by applicant and translation provided referenced below).

Shinji discloses the instantly claimed invention at the abstract supplied by the applicant and the following sections of the provided translation; DETAILED DESCRIPTION, sections [0005]-[0007] which encompasses the instantly claimed amounts and ingredients of claims 1-2. The polyimides are not crosslinked and are therefore expected to have the solubility of the instant claims 3-5. The polyimides of the reference are those of the instant claims 6-7. See sections [0005] of DETAILED DESCRIPTION describing the polyimide, and sections [0010]-[0020]. The epoxies of sections [0034]-[0035] appear to fall within the scope of the instant claim 9.

4. Claims 1-9 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 06-264035 Shinji et al. (Abstract provided by applicant and translation provided referenced below).

Art Unit: 1714

Shinji discloses the instantly claimed invention at the abstract supplied by the applicant and the following sections of the provided translation; DETAILED DESCRIPTION, sections [0005]-[0007] which encompasses the instantly claimed amounts and ingredients of claims 1-2. The polyimides are not crosslinked and are therefore expected to have the solubility of the instant claims 3-5. The polyimides of the reference are those of the instant claims 6-7. See sections [0005] of DETAILED DESCRIPTION describing the polyimide, and sections [0010]-[0020]. The epoxies of sections [0034]-[0035] appear to fall within the scope of the instant claim 9.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed amounts of ingredients and ingredient combinations in the compositions and articles of Shinji because these amounts of ingredients and ingredient combinations are encompassed by Shinji and would have been expected to give the properties described by Shinji. The applicant has not demonstrated unexpected results over Shinji in a manner commensurate in scope with the disclosure of Shinji and the instant claims.

5. Claims 10-20 are allowable over the prior art. US Pat. No. 5639808 Coggio et al. is representative of the closest prior art but does not disclose the inventions of the instant claims 10-20 nor is proper motivation seen to modify the prior art considered into the instantly claimed invention.

6. Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

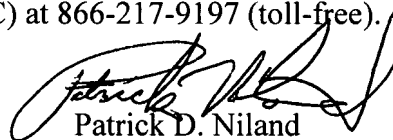
Art Unit: 1714

The prior art does not disclose phenol resins having all of the required moieties in the instantly claimed invention nor provide motivation to use such phenol resins in the instantly claimed invention.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland  
Primary Examiner  
Art Unit 1714